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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,240	12/18/2001	Hiroshi Tanaka	0879-0366P	8756

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EXAMINER

FOSTER, ROLAND G

ART UNIT PAPER NUMBER

2645

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/020,240

Applicant(s)

TANAKA ET AL.

Examiner

Roland G. Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/13/02 & 6/10/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections Using Sesek as a Base Reference

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4-7, and 9-13 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0103144 A1 to Sesek et al. (hereinafter "Sesek").

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

With respect to claim 1, Sesek discloses a communications terminal (Fig. 2, digital camera 10), which comprises a receiving device (Fig. 1, address memory 85) for receiving

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connection information (in the form of telephone number data) for making communication connections to the communications apparatus (remote device 235) from cellular phone 200 (paragraphs 0034-0035). Sesek also discloses a transmitting and receiving device (transmitter/receiver circuit 55) which sends and receives information to and from the communication apparatus (remote device 235) based on connection information received from the cellular phone 200 (paragraphs 0034-0035).

Claim 7 differs substantively from claim 1 in that claim 7 recites that the receiving device receives a "menu of destinations", which reads on user interface 50 that operates via a menu interface (paragraph 0022) that allows the user to specify the addresses (paragraph 0034). Claim 7 also recites an "input device", which reads on user interface 50.

Claim 10 differs from claims 1 and 7 in that claim 10 focuses on the cellular phone components of the communication system, which Sesek discloses as cellular phone 200 (see the claim 1 rejection). The cellular phone 200 comprises a recording device containing connection information (addresses/lists 215), a transmitting device that sends connection information to the communications terminal (the transmitter in the "short range radio frequency signal" part of RF transceiver 205, paragraph 0028), a first receiving device that receives information from the communication terminal (the receiver part in the "short range radio frequency signal" part of RF transceiver 205), a first transmitting and receiving device (the transmitter and receiver in the "high-frequency" transceiver of cellular telephone, paragraph 0027). See the claim 1 rejection

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for further details, especially regarding the previously discussed "communication terminal" components.

Claim 12 differs substantively from claims 1, 7, and 10 in that claim 12 recites additional limitations. Specifically, the first transmitting and receiving device performs a "dial-up connection" and "sends connection information" and "thereafter send and receive information to and from the communication apparatus." These limitations reads on Sesek, which discloses that the cellular telephone places a dial up connection via the cellular network to the remote device 225, in the course of which "connection information" would be sent (e.g., the dialed telephone number). Thereafter, the data related to image transfer is sent to and from the remote device 225 (communication apparatus) (paragraph 0037).

With respect to claims 2 and 6, see paragraph 22.

With respect to claims 4, 9, 11, and 13, see the claim 12 rejection for further details regarding a dial-up telephone number. See also paragraph 0037.

With respect to claim 5, the user browses the addresses (connection information) corresponding to various communication apparatus that are stored on the cellular phone (paragraphs 0034-0038). Thus the user designates the communication apparatus based on the connection (address) information received from the cellular telephone. Further, the transmitting and receiving device (transmitter/receiver circuit 55) sends and receives information to and from

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the designated communication apparatus (remote device 235) based on connection information.

See the claim 7 rejection for further details regarding an "inputting device."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sesek as applied to claims 1 and 7 above.

Although Sesek discloses a digital camera (recording device), Sesek fails to disclose: 1) that the digital camera records a batch file in which a file name to be sent or received or, 2) that the content of a service is written in advance and that the transmitting and receiving device reads out the batch file and sends the file to the communication apparatus on the network.

However, "Official Notice" is taken that both the concept and advantages of a digital camera that records a batch file where the file name or contents is written in advance, where the file is read out and sent to a communication apparatus on the network would have been well known in the art. Specifically, it is well known function of digital cameras to have a batch file creation function, where the file name is created in advance so that a batch of pictures may be stored and eventually sent to a communication device.

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Therefore, it would have been obvious to add this feature to Sesek.

The suggestion/motivation for doing so would have been to increase user-friendliness and versatility of digital camera, picture storage by allowing the user to specify a filename that the user can easily remember and then use this filename to store pictures, which are transferred to a remote device such as a computer where the file name allows for easy storage and retrieval. Such a process is notoriously well known in the art of digital cameras.

Claim Rejections Using Parulski as a Base Reference

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,943,603 to Parulski et al. (hereinafter "Parulski").

With respect to claim 1, Parulski discloses a communications terminal (combined cellular telephone/digital camera) (Fig. 7-9). The communications terminal comprises a receiving device (control processing unit 62) for receiving connection information (in the form of standard fax

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connection modes such as group VI fax) from a communication apparatus (destination fax machine) in order to properly transmit the stored image to the destination fax (col. 4, lines 50-67). Note that Group IV fax specifies a machine which operates at 64 Kps, which can only work on a digital channel, and which takes six seconds to transmit a 8 ½ x 11 page, and which supports certain progress codes. Thus, the Group IV connection mode strongly relates to connection information (e.g., digital, transmission speed, etc.). The connection information is received from (via) the cellular telephone (Fig. 7) part of the communication terminal. Thus, the connection information is for making a communication connection to the communication apparatus from a cellular phone. Parulski also discloses that the communication terminal comprises a transmitting and receiving device (cellular transceiver 66), which transmits and receives information to and from the communication apparatus (destination fax machine) based on the connection information received from (via) the cellular telephone receiver. For example, the transmitting and receiving device (transceiver 66) will have to support 64 Kps digital channel and certain fax progress codes (connection information). Thus, the information transmitted and received is based on the connection information.

Claim 7 differs substantively from claim 1 in that claim 7 recites that the receiving device receives a "menu of destinations", which reads on camera display screen, which supports a menu of icons for the user to select, where the icons refer to destinations (Fig. 6 and col. 3, line 64 – col. 4, line 9). Claim 7 also recites an "input device", which reads on pen or stylus used to select the displayed icons.

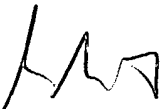
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone number for this group is (703) 872-9309.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306-0377.



Roland G. Foster
Primary Patent Examiner
September 20, 2004